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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,188	12/27/2000	Tadayoshi Iijima	P107424-00019	2973

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WASHINGTON, DC 20036

EXAMINER
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BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/748,188

Applicant(s)

IIJIMA, TADAYOSHI

Examiner

Kevin M. Bernatz

Art Unit

1773

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 30 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 30 May 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

KMB  
June 8, 2006

*Kevin M. Bernatz, PhD*  
Kevin M. Bernatz, PhD  
Primary Examiner

Continuation of 11. does NOT place the application in condition for allowance because: applicants argue that the present claims are allowable since they represent an unexpected improvement over the prior art. The Examiner respectfully disagrees.

Applicants are reminded that for a showing of unexpected results, the claims must be commensurate in scope to the showing of unexpected results. Applicants are contending that the claim limitations in claim 8 are commensurate in scope to the showing in Table 1 (Examples 1 - 6 and Comparative examples 1 - 3).

First, the Examiner notes the volume ratios are not the same (claim 8 should recite 0.037 - 9.3). As a side note, the Examiner also notes that 0.03 volume percent is also new matter since the value 0.03 is not found in anywhere in the originally filed disclosure.

Second, the Examiner notes that the pressure used in these examples are 183 - 347 N/mm<sup>2</sup>, which is very different than the range of "at least 44 N/mm<sup>2</sup>".

Third, the Examiner notes that the haze appears to be part of the unexpected results observed by applicants (see applicants' specification, page 8: "a low electrical resistance value and little scattering"; and page 9: "surprisingly ... it has been found out that a transparent conductive film having a mechanical strength, a low electric resistance value, and little scattering ..."; etc). The present claims do not recite any limitations directed to the haze value.

Fourth, all of applicants' examples use a single resin and a single type of particle. While the specification implies that the resin and conductive particle is not critical, there appears to be insufficient evidence to support that allegation.

However, even presuming that the claims were made commensurate in scope to the showing of alleged unexpected results, the results themselves must be unexpected. The Examiner need only look to Application Example 1 in JP '631 A to see that the results are not unexpected, but would have been expected by one of ordinary skill in the art. Specifically, Application Example 1 in JP '631 A uses a weight ratio of 0.03 wt% resin to 3 wt% conductive filler (or 1/100), which corresponds to examples 3 and 4 in applicants Table 1 (1/100 wt% => 3.7 vol%). JP '631 A shows excellent surface resistance and a haze of 0.4 %. As such, the Examiner does not find applicants' arguments that the results are unexpected, since when compared to the closest prior art, substantially identical properties are reported..